UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/488,195	06/07/95	RONNING J	10678.1US01

22M2/0114

MERCHANT GOULD SMITH EDELL
WELTER AND SCHMIDT
3100 NORWEST CENTER
90 SOUTH SEVENTH STREET
MINNEAPOLIS MN 55402-4131

EXAMINER	
LAUFER, P	
ART UNIT	PAPER NUMBER
2202	10

DATE MAILED: 01/14/97

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

Office Action Summary

Application No.	Applicant(s)
08/488,195	Joel A. Ronning
Examiner 703 306 4160 Pinchus M. Laufer	Group Art Unit 2202

☒ Responsive to communication(s) filed on *Dec 2, 1996* .

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-27* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1-27* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☒ The proposed drawing correction, filed on *Dec 2, 1996* is ☒ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____ .

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). *5, 6, & 9*

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Part III DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claims 1-26 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 14:
The phrases "separate storage medium" (claim 1 line 11, claim 14 lines 10-11) and "independent driver" (claim 1 line 21, claim 14 line 14) are unclear. Separate from what? Independent from what? These ambiguities render the claims (and those dependent therefrom) indefinite, as they do not "particularly point out and distinctly claim" the subject matter which applicant regards as his invention.

Claim 13 and 26:

> Claim 13: "on any digital computer having components capable of processing computer readable program code of the selected software program"
>
> Claim 26: "the computer being any digital computer having components capable of processing computer readable program code of the software programs"

The amended language lacks precision. It can be read (1) as a tautology (2) as an attempt to describe the user's computer (which is not part of the claim!) or (3) requiring it to run on any computer - which doesn't prevent that computer from needing additional hardware or software in order to make it run.
For examination purposes the phrase was treated as in claim 27 - requiring the system to function without special (additional) structure.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. Claims 1-3, 5, 8-16, 18, and 21-27 are rejected under 35 U.S.C. § 102(e) as being anticipated by Cooper ('946). With respect to claims 1 and 14 as best understood, Cooper ('946) has an image file containing the software (in encrypted form) and a "software driver" to access this file. Time limited use (claim 8) and preventing enabling after a predetermined number of samples (claim 5) are found at column 8 lines 44-49. Icons for identifying the software is inherent in the graphical interface of this application (see for example figure 8 which uses icons for selecting functions). With respect to claims 2 and 3, the monitor must correlate the software package to the trial usage in order to perform its function with more than one program.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

5. Claims 13, 26, and 27 are rejected under 35 U.S.C. § 103 as being obvious over Grantz ('038). Grantz does not explicitly teach generating a code which identifies a specific software program in a multiplicity of programs. However, Grantz does specify in column 1 that the licensing can be implemented for multiple software products which are distributed with the system in a restricted form. Therefore, if it is not inherent, it is certainly obvious that the code which monitors the trial usage must also indicate which software package is being tried.

6. Claims 6 and 19 are rejected under 35 U.S.C. § 103 as being unpatentable over Cooper ('946) in view of Tobin ('890). Tobin ('890) teaches disabling the program if comparison of counters indicates that an attempt to get around the system has occurred. (bottom of column 8). It would have been obvious to modify Cooper ('946) to include means for detecting whether unauthorized duplication is attempted and disabling the sampling in response because of the motivation of both Cooper and Tobin - that is, the desire to protect the software supplier from unfair use of the product.

7. Claims 7, 10, 20, and 23 are rejected under 35 U.S.C. § 103 as being unpatentable over Cooper ('946). With respect to claims 7 and 20, Cooper ('946) does not teach displaying the number of samples remaining. It would have been obvious to implement Cooper ('946) with the display this number (which is available) because awareness of the number of remaining trials acts as an inducement to the potential buyer to decide whether to purchase additional access and to avoid alienating a legitimate customer by rendering the program inoperative without forewarning. With respect to claims 10 and 23, in the alternative that the icons are not inherent in Cooper ('946), the prevalent use of icons for "user-friendly" operation would have made it obvious at the time of the invention to use icons in Cooper to select the software to be enabled.

8. Claims 4 and 17 are rejected under 35 U.S.C. § 103 as being unpatentable over Cooper ('946) in view of Ogaki ('799). Cooper ('946) is directed towards on-line vending of software. Ogaki teaches maintaining records of the usage and sale of each software item and transmitting this information to the central host (column 6 lines 48-50). Ogaki also teaches separating the software offerings by category (column 3 lines 42-45). Therefore, it would have been obvious at the time of the invention to implement Cooper so as to process the information to determine the most frequently requested category (or any other financial information) because this enables the vendor to make decisions regarding resource allocation.

Drawings

9. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 2 December 1996 have been approved by the examiner.

Conclusion

10. Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL.** See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Information Regarding Communication with the PTO

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pinchus M. Laufer whose telephone number is (703) 306-4160. The examiner can normally be reached on weekdays from 7:30 am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. T. Tarcza, can be reached on (703) 306-4171. The fax phone number for this Group is (703) 306-4195.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 306-4177.

Pinchus M. Laufer
January 7, 1997
PML

Thomas H. Tarcza

THOMAS H. TARCZA
SUPERVISORY PATENT EXAMINER
GROUP 2200